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EXAMINER

COOLEY, CHARLES E

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/15/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

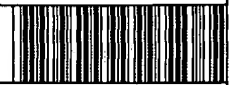
Office Action Summary

Application No.
09/817,698

Applicant(s)
May et al.

Examiner
Charles Cooley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 7, 24-29, and 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-23, and 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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OFFICE ACTION

1. This application has been assigned to Technology Center 1700, Art Unit 1723 and the following will apply for this application:

a. Please direct all written correspondence with the correct application serial number for this application to Art Unit 1723.

b. Telephone inquiries regarding this application should be directed to the Technology Center 1700 receptionist at ☎(703) 308-0651 or to the Examiner at ☎(703) 308-0112. Official facsimile correspondence filed before a final office action should be transmitted to ☎(703) 872-9310. Official facsimile correspondence which responds to a final office action should be transmitted to ☎(703) 872-9311. All *post-allowance* papers (e.g., Information Disclosure Statements, Rule 312 Amendments, petitions, etc.) should be mailed to **Box Issue Fee** or submitted via facsimile to ☎(703) 308-5864.

Election/Restriction

2. Applicant's election of the species of Fig. 34 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a))

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3. Claims 2, 7, 24-29, and 37-42 are thereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 4.

Priority

4. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. § 119(e).

Information Disclosure Statement

5. Note the attached PTO-1449 form submitted with the Information Disclosure Statement filed 20 APR 2001.

Drawings

6. Applicant should verify that (1) all reference characters in the drawings are described in the detailed description portion of the specification and (2) all reference characters mentioned in the specification are included in the appropriate drawing Figure(s) as required by 37 CFR 1.84(p)(5).

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Specification

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. The disclosure is objected to because of the following informalities:

a. Page 1: the status of the copending applications should be updated as appropriate.

b. Page 4, lines 13 and 15 contain extraneous periods.

9. The Abstract of the Disclosure is objected to because:

a. it lacks substance as it is not an adequate and clear statement of the contents of the disclosure. A reading of the abstract does not provide the character of the subject matter covered by the disclosure. The abstract should be more comprehensive of the disclosed subject matter.

Correction is required. See MPEP § 608.01(b).

10. The title is acceptable.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 14-16 and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,213,929 to May. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are anticipated by the patented claims. See *In re Goodman*, supra.

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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14. Claims 1, 3, 4, 5, 6, 7, 8, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Franzen et al. (US 5,364,335).

The patent to Franzen et al. (US 5,364,335) discloses a centrifuge apparatus comprising a filter head 2; a housing 59a, 59b, 59d connected to the filter head; a rotatable filter 56 disposed within the housing; the filter having an inlet 7 and an outlet 76; inherently replaceable filter media 66 for improving the filtering efficiency of the solids constituent from the feed fluid (Col. 7, lines 15-23); electric motor drive 10a or 10b carried by the filter head with a rotatable output shaft 5 coupled with the filter for rotating the filter; and fixed shafts 17a and 50.

15. Claims 1, 3, 4, 5, 6, 7, 8, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Drury (US 2,647,686).

The patent to Drury (US 2,647,686) discloses a centrifuge apparatus comprising a filter head 28; a housing 10, 51 connected to the filter head; a rotatable filter 24 disposed within the housing; the filter having an inlet 58 and an outlet 43; inherently replaceable filter media 41, 47 for improving the filtering efficiency of the solids constituent from the feed fluid; electric motor drive 26 carried by the filter head with a rotatable output shaft 20 coupled with the filter for rotating the filter; and fixed shafts 15 and 58.

16. Claims 1, 3, 4, 5, 6, 7, 8, 9, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hohmann et al. (US 4,891,041).

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The patent to Hohmann et al. (US 4,891,041) discloses a centrifuge apparatus comprising a filter head 1; a housing 13 connected to the filter head; a rotatable filter 5 disposed within the housing; the filter having an inlet (top part of 20) and an outlet 24; inherently replaceable filter media 21 for improving the filtering efficiency of the solids constituent from the feed fluid (Col. 4, lines 4-20); electric motor drive 2 carried by the filter head with a rotatable output shaft 3a coupled with the filter for rotating the filter; fixed shaft 20; and controller 28.

17. Claims 1, 3, 4, 5, 6, 8, 9, 10, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Vado et al. (US 5,656,164).

The patent to Vado et al. (US 5,656,164) discloses a centrifuge apparatus comprising a filter head 14; a housing 2 connected to the filter head 14; a rotatable filter 9 disposed within the housing; the filter having an inlet 12 and an outlet 7; inherently replaceable filter media 11 for improving the filtering efficiency of the solids constituent from the feed fluid; electric motor drive 3 carried by the filter head with a rotatable output shaft 6 coupled with the filter for rotating the filter; and speed controller 17, 18.

18. Claims 1, 3, 4, 5, 6, 8, 14, 16, 17, 18, 19, 20, 21, 22, 34, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gold et al. (US 2,745,217).

The patent to Gold et al. (US 2,745,217) discloses a centrifuge apparatus comprising a filter head 10; a housing 14, 16 connected to the filter head 10; a rotatable filter 17 disposed within the housing; the filter having an inlet 30 and an outlet 21; inherently replaceable filter media 29; electric motor drive 25 carried by the filter head

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with a rotatable output shaft 24 coupled with the filter for rotating the filter; and vacuum device 27 carried by the filter head.

19. Claims 1, 3, 6, 7, 8, 14, 18, 19, 20, 21, 22, 34, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Boyland (US 3,007,629).

The patent to Boyland (US 3,007,629) discloses a centrifuge apparatus comprising a filter head 11, 12; a housing 10 connected to the filter head; a rotatable filter 13 disposed within the housing; the filter having an inlet 38 and an outlet 36; inherently replaceable filter media 32, 36 or 40, 41; motor drive 17 carried by the filter head with a rotatable output shaft 16 coupled with the filter for rotating the filter; and vacuum device 28 or 30 carried by the filter head.

20. Claims 1, 3, 6, 7, 8, 9, 10, 11, 12, and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Onodera et al. (US 5,779,618).

The patent to Onodera et al. (US 5,779,618) discloses a centrifuge apparatus comprising a filter head (proximate 23); a housing 10 connected to the filter head; a rotatable filter 11 disposed within the housing; the filter having an inlet 14 and an outlet 19; inherently replaceable filter media 15; drive 21 carried by the filter head with a rotatable output shaft 21a coupled with the filter for rotating the filter; fixed shaft (above 19); controller 25; and engine 1.

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* * *

With respect to claims 19-20, the claimed fluid medium is material worked upon and does not limit apparatus claims (MPEP 2115). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Claim Rejections - 35 U.S.C. § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

23. Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gold et al. (US 2,745,217) or Boyland (US 3,007,629) in view of Jacobson et al. (US 3,942,716).

The patents to Gold et al. (US 2,745,217) and Boyland (US 3,007,629) do not disclose the check valve. Jacobson et al. (US 3,942,716) discloses a centrifuge with a vacuum device 15 or 47 which employs a check valve 50. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the devices of Gold et al. (US 2,745,217) or Boyland (US 3,007,629) with a check valve for the purpose of controlling the flow of the fluid medium through the centrifuge.

24. Claims 1, 3, 4, 5, 6, 7, 9, 10, 11, 12, 13, 14, 15, 18, 19, 20, 21, 23, 30, 31, 32, 33, 34, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Penny (US 5,904,841) in view of Vado et al. (US 5,656,164).

Penny (US 5,904,841) discloses a centrifuge apparatus comprising a filter head 101; a housing 14 connected to the filter head; a rotatable filter 12 disposed within the housing; the filter having an inlet 105 and an outlet 108; reaction drive 18; venturi vacuum device 112 in the filter head; check valve 125; engine 51; and fixed shaft 107.

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Penny (US 5,904,841) does not disclose the electric motor drive, controller, or the filter media. The patent to Vado et al. (US 5,656,164) discloses a centrifuge apparatus comprising a filter head 14; a housing 2 connected to the filter head 14; a rotatable filter 9 disposed within the housing; the filter having an inlet 12 and an outlet 7; inherently replaceable filter media 11 for improving the filtering efficiency of the solids constituent from the feed fluid; electric motor drive 3 carried by the filter head with a rotatable output shaft 6 coupled with the filter for rotating the filter; and speed controller 17, 18. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have substituted the drive in Penny with an electric motor drive controlled by a speed controller as disclosed by Vado et al. for the purpose of positively driving the filter at a selected speed as opposed to unreliable reaction drive which is not speed controllable and to have provided Penny with a filter media in the filter for the purpose of trapping solids (col. 2, lines 13-15 and 50-52 and col. 3, line 5).

With respect to claim 33, Penny does not show the filter attached to the engine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have attached the filter to the engine, e.g., to form an integrated assembly, since it has been held that rearranging parts of an invention which rearrangement does not modify the operation of the device involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) and MPEP 2144.04.

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Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☎ (703) 308-0112.

27. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☎ (703) 308-0651.

Dated: 11 July 2003



**Charles Cooley
Primary Examiner
Art Unit 1723**